

PATENT APPLICATION
Serial Number 09/392,585
Our Ref: Q55716

of ordinary skill in the networking art at the time the invention (sic.) to determine the details of how the franking machine is electrically isolated.” *See*, Office Action, page 3.

The pertinent portion of claim 1 recites as follows:

A process for monitoring the consumptions of a plurality of franking machines through a public communication network, at least one of the franking machines being electrically isolated from the public communications network....

It is apparently the Examiner’s position that a person of ordinary skill in the art would not know how to electrically isolate a franking machine from a public communications network. Applicants respectfully disagree. As explained in detail in the latest telephonic interview with the Examiner, this recitation in claim 1 merely means that the particular franking machine is not connected to a network. This would be akin to having a PC that does have not a modem, and therefore, is electrically isolated from the internet. For the Examiner to contend that a person of ordinary skill in the art would not know how to provide a franking machine that is electrically isolated from the public communication network is nonsensical. In fact, as discussed in great detail in the specification, many of the franking machines that are currently in use are not capable of being electrically connected to a communication network. For example, the specification states:

Now, more than 100,000 additional electro-mechanical franking machines exist at the present time, on the French territory alone, which do not present this possibility of connection to a remote data-processing server.

See, specification, page 2, lines 1-4.

PATENT APPLICATION
Serial Number 09/392,585
Our Ref: Q55716

Thus, it appears that the Examiner's position is that it would require undue experimentation for one of ordinary skill in the networking art to determine how franking machines are electrically isolated from a communication network when, in fact, there are literally thousands of franking machines that are electrically isolated. In other words, a person of ordinary skill in the art simply needs to look around at all of the franking machines that are not electrically isolated to understand how to practice this aspect of the invention. Accordingly, it is submitted that the Examiner's rejection based on § 112 (first paragraph) is entirely unsupported. Thus, it is requested that this rejection be withdrawn.

Turning to the prior art rejection based on the combination of Pierce, et al. (U.S. Patent No. 6,151,591) and Bernard, et al. (U.S. Patent No. 5,717,596), Applicants agree with the Examiner's statement that Pierce, et al. does not disclose a franking machine being electrically isolated from the public communications network. On the other hand, Applicants respectfully disagree with the Examiner's assertion that Bernard, et al. discloses a franking machine which is electrically isolated from the public communication network. One can simply look at Figure 1 of Bernard, et al. and realize that the franking machine is electrically connected a communication network via a modem 22. Accordingly, it is respectfully submitted that the cited art, taken singularly or in combination, fail to teach or suggest the present invention recited in the claims.

Furthermore, Applicants respectfully submit that the rejection, on its face, is improper in view of the Examiner's obviousness assertion. More specifically, the Examiner states as follows:

PATENT APPLICATION
Serial Number 09/392,585
Our Ref: Q55716

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to incorporated (sic.) Bernard's teachings method and system (sic.) for franking, accounting, and billing of mail services with the teachings of Pierce, for the purpose of preventing fraudulent and inadvertent dispensing of postage [see Bernard, Col. 2, lines 34-40].

Office Action, page 4.

Even a cursory review of the Examiner's obviousness assertion demonstrates that the Examiner has failed to explain how a person of ordinary skill in the art would have modified the device of Pierce in view of the teachings of Bernard. Rather, the Examiner makes a broad statement that it would have been obvious to incorporate the teachings of Bernard into the teachings of Pierce for preventing fraudulent and inadvertent dispensing of postage meter. The problem with the Examiner's position is that it does not provide Applicant with any indication as to how the Pierce device would have been modified. Thus, its face, the rejection is improper and should be withdrawn.

Furthermore, Applicants note that the problem identified by the Examiner (i.e., preventing fraudulent and inadvertent dispensing of postage) is not the problem addressed by the present invention. To the contrary, the problem addressed by the present invention is for a user to know the state of the indexes of all his or her machines, connected and not connected, without reading them at the level of each machine (in "not connected" franking machines the indexes can only be read in situ on the board of the machine). This problem is not addressed or disclosed in any of the cited references. In view of the foregoing, it is respectfully submitted that the claims patentably distinguish over the cited art taken singularly or in combination.

PATENT APPLICATION
Serial Number 09/392,585
Our Ref: Q55716

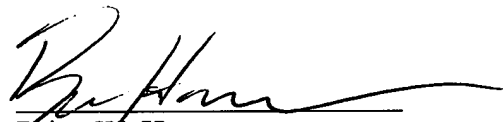
In paragraph 13 of the Office Action, the Examiner asserts that the claims are unduly broad in view of the breadth and depth of the franking machine art. The Examiner specifically notes that Pitney Bowes holds a number of "art defining patents in this technology area". Thus, the Examiner has requested that Applicants amend the claims to distinguish over these "art defining patents" of Pitney Bowes. The Applicants would like to remind the Examiner that the assignee of the subject application (Neopost) holds many patents in the franking technology area (more than 100 U.S. patents in this field). Further, Neopost is the first e-company in this field in the USA. There is no equivalent to the approved USPS (simply postage) service in Pitney Bowes services. In short, based on the rejections presented in the outstanding Office Action, it is clear that the claims are not "unduly broad" as the Examiner contends. Rather, they patentably distinguish over the best art cited by the Examiner, both patents of which are assigned to Pitney Bowes. Of course, if the Examiner believes that there is another Pitney Bowes patent that is more relevant, he is welcome apply that patent to the claims. Otherwise, the Examiner should allow the application.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

PATENT APPLICATION
Serial Number 09/392,585
Our Ref: Q55716

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



Brian W. Hannon
Registration No. 32,778

SUGHRUE, MION, ZINN,
MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

Date: October 16, 2001